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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/577,386

05/23/2000

Mark Lesswing

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29053

7590

05/31/2006

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/577,386	LESSWING ET AL.	
	Examiner	Art Unit	
	Vanel Frenel	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 24-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 24-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 12/02/05. Claims 1-11 and 24-86 are pending.
2. Applicant's argument filed on 12/2/05 regarding the rejection under 35 U.S.C 101 has been persuasive, hence the previous rejection pertaining to the 101 rejection is hereby withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 and 24-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarter et al (5,704,044) in view of Bosco et al (5,191,522), for substantially the same reasons given in the prior Office Action, and incorporated herein. Further reasons appear hereinbelow.

Response to Arguments

5. Applicant's arguments filed on 12/02/05 with respect to claims 1-11 and 24-86 have been fully considered but they are not persuasive. Applicant's arguments will be

addressed hereinbelow in the order in which they appear in the response filed on 12/02/05.

(A) At pages 2-13 of the 12/02/05 response, Applicant's argues the followings:

(a) The restriction requirement is improper and there is no serious burden for the Examiner to examine the claims at issue.

(b) The removal of the rejection under 35 U.S.C. 101.

(c) The combination of Tarter and Bosco does not teach or suggest all the limitations of claims 1-11 and 24-86.

(d) Tarter does not teach nor suggest qualification of codes, calculation codes, priority notes and "arranging the plurality of terms, of said contract, into a sequential series of terms, identifying a term as a matching term associated to the claim line when a claim code of the claim line is substantially equal to the qualification code and programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms" in claims 1, 40, 65, 71, 79, 82 and 84.

(e) Tarter does not teach or suggest computer readable program code causing a computer to generate a rate sheet which represents a contract, of the at least one contract, the rate sheet containing one or more rate terms that represent the contractual terms of the contract, and containing a rate identifier code that represents the contract identifier of the contract in claims 24 and 53. The rejection is improper.

(B) With respect to Applicant's first argument, Examiner respectfully submitted that Group III of the Restriction recited slightly a method for determining a reimbursement amount of a claim which is similar to the claims of Group I is therefore rejected for the same reasons given in the previous Office Action, and incorporated herein. Therefore, Applicant's argument is non –persuasive and the rejection is hereby sustained.

(C) With respect to the second argument, Examiner respectfully submitted that Applicant's argument has been persuasive regarding the rejection of the 35 U.S.C 101. Hence the previous rejection pertaining to the 101 rejection is hereby withdrawn.

(D) With respect to Applicant's third argument, Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one

ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In response to Applicant's concern that the Examiner have ignored the mandate of the modern case law which clearly and explicitly hold that in order for the references to be combined in that the references must explicitly teach or suggest every element of the combination as well as how to use such a combination, the Examiner respectfully submits that Applicant misinterprets the some of the case law cited. For example, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Examiner are specifically taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Therefore, Applicant's argument is non –persuasive and the rejection is hereby sustained.

(E) With respect to Applicant's fourth argument, Examiner respectfully submitted that He has relied upon the clear and unmistakable of the teaching of Bosco who stated "Any relational data base management system program may be used to manage the data base. The relational data base management system program preferably uses a Structured Query Language ("SQL"), a fourth generation computer language. The SQL package contains various program tools which may be utilized in the invention. The most important of these program tools are: SQL*PLUS, a program for creating, modifying, storing and maintaining the data base; SQL*CALC, a program with standard spreadsheet capabilities which can also access and manipulate data base information; SQL*FORMS, a program to design screens; SQL*RPT, a report writing tool; SQL*GRAPH, a business graphics feature; and SQL*MENU, an easy-to-use menu design facility. In a preferred embodiment of the invention the relational database management program is the systems program ORACLE. The enterprise group insurance relational data base makes it possible to construct an integrated group insurance information storage, processing and reporting system that is an integration of a plurality of workstation sub-systems applications each of which comprises program modules specific for a different application. The sub-systems interact within the integrated system by processing data from the single enterprise-wide relational data base. This integrated system eliminates redundancy and improves productivity. FIG. 11. is a block diagram which shows the systems functional architecture of a specific embodiment of the invention. This embodiment of the invention comprises approximately forty (40) sub-system program modules which are integrated into the

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system through the use of the single relational data base. Each block depicts a separate sub-system program module. The arrows of the lines connecting the blocks generally depict the sequence in which the program modules should be implemented in order to construct the enterprise-wide integrated system. This is so because the implementation of the downstream modules may involve the transfer of data that was processed by an upstream program module in the course of business and transferred to downstream program module for further compilation or processing (See Bosco, Col.21, lines 32-68 to Col.22, line 7). Further, Bosco discloses "within agent role, the rates are provided for varying annual premium levels, either first year or rates are provided for varying annual premium levels, either first year or renewal. Within the first year or renewal categories the rates are differentiated between person (direct) production or intermediate (indirect) production (See Bosco, Col.13, lines 20-39) and suggested that using case and census information, the rating program module 73 will generate manual rates. This function is currently most often contained in stand-alone systems in the insurance underwriting departments. The Module 73 calculates rates for both new and renewal business (See Bosco, Col.23, lines 65-68 to Col.24, line 2) which correspond to Applicant's claimed feature. Therefore, Applicant's argument is non-persuasive and the rejection is hereby sustained.

(F) Applicant's fifth argument is similar to the fourth argument and is therefore applicable for the same reason given above in paragraph (E), and incorporated herein.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

February 14, 2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER